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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/367,642	08/19/99	YASUKOHCHI	T 055303

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EXAMINER

BUTTNER, D

ART UNIT	PAPER NUMBER
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1712

DATE MAILED:

11/15/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

8-367642

Applicant(s)

YASUKOCHI

Examiner

BUTLER

Group Art Unit

1712

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-13 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-13 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☒ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).
- \*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 7, 8 and 11-13 rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The low water content critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Applicant's specification (eg page 18 line 22) appears to indicate low water content in the reaction system is required for the high purity and narrow MW. Applicant's background admits (page 3 lines 7,20) removing undesirable compounds is known in the prior art through post-polymerization purification steps.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 7 and 11 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims do not further limit the earlier claims. These claims are directed to compounds not within the scope of the earlier claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 8-10 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Kemp '016 patent.

Kemp alkoxylates compounds having an active hydrogen. The active hydrogen compound can be methyl phenol (col 4 line 33) or a C<sub>1</sub>-C<sub>10</sub> alkanol (col 4 line 42). The adduct number can be 30 or greater (col 8 line 21).

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Kemp teaches that the water content of the reactants should be kept low (col 7 line 46-53), because water changes the alkylene oxide adduct distribution of the product. This appears to be the crux of applicant's invention (page 18 line 22).

Kemps procedure results in a low content of polyakylene glycol and other by-products (col 9 line 58). Additional purification steps (col 9 line 65) can be performed. Kemp does not quantify his MW distribution and purity through chromatography, but inherently would meet the claims since the same technique (low water content) is used.

Claims 1-4, 7, 8 and 11-13 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Martinez or JO8165343 Patents.

Martinez discloses methoxy PEG (col 9 line 7) of applicant's MW. Martinez carboxylates this material in later examples. A high purity is obtained (claim 23). This carboxylated material can be then aminated (col 5 line line 54).

JO8165343 also shows methoxy PEG (examples 1,3,5-7) of applicant's MW. The material is later aminated. High purity (abstract) and narrow MW distribution (see graphs) result.

Although neither reference measures MW distribution or purity in the manner of applicant's claims, the burden of proof is shifted to applicant (MPEP 2112).

Additionally, mere purity of an old product does not render the product unobvious. (MPEP 2144.04 (VII)). This especially holds in the current situation where the prior art recognizes purity as important and references such as Kemp (col 9 line 65) and those of applicant's background (page 3) teach various methods for removing impurities.

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Claims 1-13 rejected under 35 U.S.C. 103(a) as being unpatentable over the Martinez or J08165343 Patent in combination with Kemp.

Martinez and J '343 do not suggest keeping water content low when producing their methoxy PEG.

Kemp teaches water affects the alkylene oxide adduct distribution. It would have been obvious to produce the methoxy PEG in the absence of water to keep the MW distribution narrow.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner David Buttner whose telephone number is (703) 308-2403. The examiner can normally be reached on weekdays from 10:00 am to 5:00 pm

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Buttner/ph

DAVID J. BUTTNER  
PRIMARY EXAMINER

November 13, 2000

